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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/224,202 | 12/30/1998 | LANCE R. CARLSON | 3123-233-1 | 3994 |

7590 06/14/2004

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EXAMINER

SNIEZEK, ANDREW L

ART UNIT

PAPER NUMBER

2651

DATE MAILED: 06/14/2004

26

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/224,202 | CARLSON ET AL. |
| | Examiner | Art Unit |
| | Andrew L. Sniezek | 2651 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 May 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 47-50,53-58,61-66,87,88,91-98,101-106,108-113,115,118-123,125 and 126 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 47- 50,53-58,61-66,87,88,91-98,101-106,108-113,115,118-123,125 and 126.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 5/13/04 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 47-50, 53-58, 61-66, 87, 88, 91-98, 101-106, 108-113, 115, 118-123 and 125-126 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 87 sets forth a detection circuit that determines if a head is within an acceptable flying height range in response to first and second data patterns while the head is at a substantially constant flying height. Independent claim 97 has been amended to include a detection circuit that determines whether a head is within an acceptable flying height range in response to the first and second data patterns without moving the head to a substantially different

flying height. As previously pointed out in the Final office action mailed 7/16/01, the written specification teaches that when determining when a flying height is within an acceptable range known values (threshold or calibration) obtained from at least a maximum flying height is needed. Therefore the limitations directed to "substantially constant flying height" and "without moving the head to a substantially different flying height" are not supported by the specification as filed. Dependent claims inherit the language of the respective independent claim.

Response to Arguments

Applicant's arguments filed 5/13/04 have been fully considered but they are not persuasive. Although applicant has amended the claims to deleted the phrase containing the term "independently", it is clear from applicants remarks that the determination circuit operates without any additional flying height measurements taken by moving the head. Applicant states that since the Board of Patent Appeals and Interference stated that Brown et al. requires that the drive be moved to a different reference position and therefore precludes Examiner from taking the position that Brown discloses a detection circuit that determines whether a head is within an acceptable flying height (1) while the head is at a substantially constant flying height and (2) without moving the head to a substantially different flying height. It is noted by the Examiner that the Board of Patent Appeals and Interferences also states "The disclosed invention requires that the measured flying height be compared to predetermined threshold values which are known to represent good and/or bad flying height values. The specification does not disclose that these values are obtained independently of flying height data obtained from the disk drive. There is every reason to believe that the threshold data stored in the RAM must come from previously determined measurements of the disk drive at various predetermined flying heights." These

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various predetermined heights as stated by the Board of Patent Appeals and Interferences suggests that the claimed invention of "substantially constant flying height" and "without moving the head to a substantially different flying height" as argued by applicant are not supported by the written specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Snizek whose telephone number is 703-308-1602.

The examiner can normally be reached on Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 703-308-4825. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Andrew L. Snizek
Andrew L. Snizek
Primary Examiner
Art Unit 2651

A.L.S.
June 12, 2004